

**Paragraph 11 – Response to Arguments in Previous Office Action**

The Applicant traverses all of the Examiner's assertions and accepts all of the Examiner's admissions.

The Applicant acknowledges that the Examiner admits he made a mistake in rejecting claims 1-33 on the ground that they infringed on U.S. laws set forth by Congress and the Applicant could not apply for any patent protection at all for any invention related to domain names since and the U.S. Department of Commerce was working under the authority of Congress and was under contract with ICANN for the domain name registration system that the U.S. Department of Commerce had no jurisdiction the domain name system for patent protection. The Applicant acknowledges that the Examiner withdraw this improper rejection.

In the previous Office Action, the Examiner, initially argued the claimed invention was obvious under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Examiner has not mentioned this rejection in the current office action. The Examiner has not stated as whether this rejection was withdrawn or is still in place. He only states that the Applicant's arguments to this rejection in the Applicant's response filed June 5, 2006 were not persuasive.

If the Applicant's argument were not persuasive, why did the Examiner not maintain this rejection? If the Applicant's arguments were persuasive, the Applicant requests the Examiner state for the record why they were.

Applicant requests the Examiner state for the record the status of this rejection from the previous office action with respect to the present office action.

The Applicant asserts the Examiner has mis-applied U.S. Patent Law and the associated rules several times by sending out the current Office Action. First, this second non-final rejection of this current Office Action is improper under the patent rules. Since the Applicant did not amend the claims in the previous Office Action, the Examiner was required under the patent rules to either allow all the claims or finally reject the claims. The Examiner's actions are improper and inequitable under the patent rules.

The Examiner, after reading the Applicant's previous response, commented only on the Applicant's arguments with respect to the single reference KORITZINSKY. The Examiner, apparently feeling KORITZINSKY is the Examiner best chance to reject the Applicant's claims based on the comments made by the Applicant's in its response, then created a brand new rejection over the Applicant's application itself and KORITZINSKY. The Examiner also did a new search and created new rejections with new references Cummings and Burstein. A new search was not appropriate or necessary since the Applicant did not amend the claims. These actions by the Examiner violate MPEP rule 706.07. MPEP Rules 706.07 clearly states:

*To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; Switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.*

The Examiner is requested to state for the record why he did not violate MPEP rule 706.07 , why he conducted a new search and why he raised new objections when the Applicant did not amend any claims.

### **Section §112, 2<sup>nd</sup> ¶ Rejection**

Examiner has asserted that the Applicant's claim language in Claim 1 and Claim 19 is indefinite under 35 USC §112, 2<sup>nd</sup> ¶, specifically the step of "accepting a one-time permanent registration fee" is vague and indefinite. The Applicant traverses this assertion.

### **Section §112, 2<sup>nd</sup> ¶ Response**

Astonishingly, the Examiner has now asserted for the first time that the exact claim limitation of "accepting a one-time permanent registration fee" for a permanent registration of a domain name is vague and indefinite. This is of the claim elements the Examiner admitted on Pages 6, 9, 11 and in the previous Office Action (December 5, 2005) that KORITZINSKY failed to teach. The Examiner specifically admitted that KORITZINSKY "failed to teach using the permanent registration fee to be added to a financial instrument who profit can be used to perpetually pay future renewal fees."

It is also one of the claim elements that the Examiner has asserted in the present Office Action is taught by KORITZINSKY to make an obviousness rejection. In fact after making the §112 rejection, the Examiner on page 6 of the current Office Action asserts the critical issue is the “fee payment option and facing the problem of expiring service due to non-payment” and KORITZINSKY now inherently teaches this claim limitation to further bolster his obviousness rejection.

This rejection is very suspicious to the Applicant as self-serving by the Examiner to manufacture a §112 rejection so the Applicant is forced to amend Claim 1 to further fit the claim language into the obvious rejection being manufactured by the Examiner.

The Applicant declines to amend the Claims and submits the claim language as filed is clear and definite as filed and as examined without rejection in the previous office action by the Examiner. The Applicant will point out this suspicious rejection to the Appeals Board.

### **First Section 103 Rejection**

Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29 30-31 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable of AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469).

The Applicant traverses all of the Examiner’s assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner’s assertions. The Applicant accepts all of the Examiner’s admissions.

Thus, there is clearly no motivation to combine the Applicant's Application and KORITZINSKY. Trying to do so violates the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

The Applicant has clearly shown why Claim 1 is not obvious over its own Application view of KORITZINSKY. The same arguments apply for independent claims 10, 16 and 20. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to independent Claims 1, 10, 16 and 20. Since these claims are not obvious they are all immediately allowable in their present form.

**Dependent Claims 2, 3, 9, 12-15, 17-19, 23-24, 25-29, 30-31 and 32-33**

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. All of the dependent claims add additional limitations not present in the independent claims. The Applicant has clearly pointed out why the independent claims are not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine*.

### **Second Section 103 Rejection**

Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Cummings (U.S. Patent No. 6,470,321).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

### **Second Section 103 Response**

All of the arguments for Claim 1 above are incorporated by reference for Claims 4-5 and further apply in view of Cummings. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 4-5 either alone or in combination thereof.

Thus, Claims 4-5 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 4-5 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

### **Third Section 103 Rejection**

Claims 6-8, 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Burnstein (U.S. Patent No. 7,076,541).

- 13 of 15 -

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

### **Third Section 103 Response**

All of the arguments for Claim 1 above are incorporated by reference for Claims 6-8, 10-11 and 21-22 and further apply in view of Burnstein. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 6-8, 10-11 and 21-22 either alone or in combination thereof.

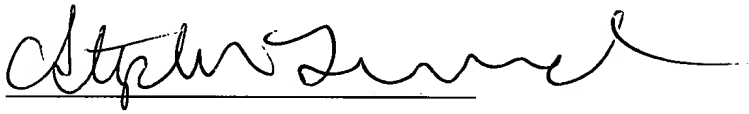
Thus, Claims 6-8, 10-11 and 21-22 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 6-8, 10-11 and 21-22 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

## CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §112 rejection and all the §103 rejections of claims 1-33 and pass all of the claims immediately to allowance.

Respectfully submitted.

**Lesavich High-Tech Law Group, PC (32097)**

A handwritten signature in cursive script, appearing to read "Stephen Lesavich", written over a horizontal line.

Dated: February 13, 2 007

Stephen Lesavich, PhD

Reg. No. 43,749



### First Section 103 Response

#### **CLAIM 1:**

The Examiner asserts that Claim 1 is rejected over "Applicant Admitted Prior Art (AAPA)." The Examiner asserts that the Applicant's invention, specifically all the elements of Claim 1 are admitted in the Background Section of the Application on pages 1-4. The Applicant traverses this assertion.

The Background section of the Applicant's application on pages 1-4 does not teach, suggest or even mention the claim limitations, including, but not limited to, a permanent registration certificate, a permanent domain name registration system, accepting a one-time permanent registration fee to perpetually pay all future renewal fees and issuing a permanent registration certificate.

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Applicant now demands the Examiner state for the record where he finds each and every claim term from Claim 1 in the Background section of the Applicant's application to establish a *prima facie* case of obviousness in the first place based on the holdings of *In re Royka*.

The Examiner then on Page 4 of his current office action asserts the Claim 1 reads over a new claim including words made up by the Examiner himself. This claim was not filed by the Applicant and is not included anywhere in the Applicant's application. The Examiner changes words in the Applicant's original claim 1 and adds self-serving allegedly equivalent words of his own not filed by the Applicant.

The Examiner inserts several words including “service,” “subscription service,” and others in the claim he has written himself.

The Examiner then absurdly asserts, that the claim he wrote himself with words he selected himself, was admitted by the Applicant’s application and makes the Applicant’s Claim 1 obvious over the Applicant’s application itself. The Applicant traverses this assertion as the Examiner’s words are not the words included in the claims as filed by the Applicant.

The Applicant’s attorney has never, in his eleven years as patent attorney seen a more bizarre attempt by an Examiner to reject the claims in an application.

The Examiner is reminded that is his job to examine applications written by Applicant’s under MPEP Rule 706 not write new claims for the Applicant and then claim they are obvious based on words the Examiner chooses. Such an exercise is clearly inappropriate and clearly not within the scope of the Examiner’s duties.

Even after adding the word service and subscription to the claim formulated by the Examiner, the Examiner admits one more time that the Applicant’s application does not teach “a one-time permanent registration fee which would result in an issuing of a permanent registration certificate” (Page 5, current office action)

The Examiner then goes onto to admit that KORITINSKY teaches another type of subscription service for renewing licenses for computer software programs used to analyze medical images (but not the permanent subscription service for domain names claimed by the Applicant) (Page 6, current office action).

By the Examiner's own words and admissions not all of the claim limitations have been taught by the Applicant's application alone or in combination with KORITZINSKY.

The Examiner has thus clearly not established a *prima facie* case of obviousness for the claimed invention in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Applicant need not respond any further. However, for completeness the Applicant responds as follows.

The Examiner is appearing to rely on words he selected for the claims he wrote himself and the teachings of KORITZINSKY being equivalent to that of the Applicant. The Examiner is reminded that in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue could be functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (or based on words the Examiner makes up himself).

The Applicant now demands that the Examiner provide evidence of such equivalence from the prior art supporting the assertion that a subscription service for software to view medical images is the same as the permanent registration service for domain names claimed by the Applicant. The Examiner has not provided any such equivalency evidence from the prior art at all required under the holding of *In re Ruff*.

The Examiner then admits once again that the subscription service in KORITZINSKY deals with subscribing to a diagnostic system/service for software licenses.

The Examiner then conveniently asserts that “the type of subscription service is not critical” and “as for the difference in the type of subscription services, this not critical,” to further bolster his arguments for obviousness without any proof whatsoever.

The Examiner has provided no evidence of any kind for conveniently saying the type of subscription service is “not critical” other than to bolster his obviousness rejection.

The Examiner is reminded it is never appropriate to rely solely on knowledge without evidentiary support in the record as the principal evidence upon which a rejection was based. See, *In re Zurko*, 258 F.3d 1379, 59 (Fed. Cir. 2001) and *In re Ahlert*, 424 F.2d 1088 (CCPA 1970).

The Applicant now demands the Examiner provide evidentiary support from the references cited by the Examiner, that is, the current record, that supports his assertion that “the type of subscription service is not critical” under the holdings of *In re Zurko* and *In re Ahlert*.

The Examiner then asserts the subscription service of KORITZINSKY reads over the claim limitation of a “one time permanent registration fee used to perpetually pay all future renewal fees for the domain name registration” and is inherently included in the teachings of KORITZINSKY. The Applicant traverses this assertion.

Not only did the Examiner admit several times in two Office actions that KORTIZINSKY did not teach this claimed feature, the Examiner has not provided any proof of inherency. The Examiner also made assertions with no proof whatsoever that certain things taught by KORITZINSKY were not critical without any proof and then immediately jumps to equivalence by inherency.

The Examiner is reminded that to establish inherency in the first place, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner clearly has not met the burden of proof for inherency under In re Robertson. No person skilled in the art, when viewing the teachings of KORITZINSKY that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate or permanent domain name registration system or any of the other additional limitations described by the claimed invention.

The Applicant requests the Examiner provide extrinsic evidence that makes clear that the missing descriptive matter is necessarily present in the cited claim elements claimed by the Applicant could exist in KORITZINSKY that someone skilled in the art would agree with.

The Examiner is also reminded that obviousness can only be established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). If a proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

One of the principal operations of KORITZINSKY, is to provide a novel approach to handling imaging and diagnostic system protocols. The technique is employed on centralized management stations, such as a station linking several scanners in a radiology department of a medical institution. (Col. 2, lines 39-66). No radiology of a medical institution would have any interest in providing a permanent domain name registration system as claimed by the Applicant. Trying to combine the Applicant's invention with KORITZINSKY, renders KORITZINSKY unsatisfactory for one of its intended purposes and changes its principal operation, namely, allowing a radiologist to view medical images to make health diagnosis on patients. Trying to combine the Applicant's invention with KORITZINSKY may endanger the health of patients of a medical institution and would constitute an improper use of the scanners and management stations in radiology department.